1636

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors	:	Ernest Arenas et al.
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Examiner	:	Gerald G. Leffers, Jr.
Group Art Unit	:	1636
Title	:	MATERIALS AND METHODS RELATING TO NEURONAL DEVELOPMENT

Suite 720
1601 Market Street
Philadelphia, PA 19103
(215) 563-4100 (telephone)
(215) 563-4044 (facsimile)
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April 21, 2003
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Janice M. Nightlinger
Janice M. Nightlinger

Assistant Commissioner
for Patents
Washington, D.C. 20231

TRAVERSAL AND REQUEST FOR RECONSIDERATION OF REQUIREMENT FOR RESTRICTION

Dear Sir:

Applicants, through their undersigned attorneys, hereby traverse and request reconsideration of the requirement for restriction set forth in the Official Action dated March 19, 2003 in the above-identified patent application.

At the outset, it is noted that an initial shortened statutory response period of one (1) month was set in the

March 19, 2003 Official Action. This Traversal And Request For Reconsideration Of Requirement For Restriction is being filed within the initial response period, as April 19, 2003 fell on a Saturday.

The restriction requirement in this case is plainly improper for failure to comply with the relevant provisions of the Manual of Patent Examining Procedure (M.P.E.P.) pertaining to unity of invention determinations.

The present application was filed under 35 U.S.C. §371 as a U.S. national stage application under the Patent Cooperation Treaty.

As stated in 1893.03(d) of the M.P.E.P.:

> Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. 371) applications...
>
> The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.
>
> A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art....

In the present case, all of the pending claims include the special technical feature of having neuronal stem or progenitor cells over-expressing Nurr1 in the presence of Type I astrocyte factors. Many of the claims that the Examiner has placed in different groups in fact are dependent on claim 1 and refer back to it, and therefore, necessarily require exactly the special technical feature recited in claim 1. Other groups of claims have exactly the same language and the same feature. The recitation of additional features in a claim does not eliminate an essential feature from the claim, nor does it eliminate the special technical feature from the claim. Thus, the Examiner's observations that inventions of other groups "could be obtained from alternative sources or by alternative methods", and that other groups "compromise additional special technical features not present in or required for the methods of Group I (e.g. administration of a medicament to an individual)" are irrelevant.

The impropriety of this requirement is underscored by the fact that there was no lack of unity objection during the international stage of this application. Rather, the subject matter of all of the claims was treated as a single inventive concept.

As the March 19, 2003 Official Action fails to comply with established United States Patent and Trademark Office unity of invention practice, it is respectfully submitted that this requirement should be reconsidered and withdrawn.

In order to be fully responsive to the above-mentioned requirement, applicants hereby elect the subject matter of Group I, i.e. claims 1-12, 19-21 and 32-40 for examination in this

application.

Applicants' election in response to the present restriction requirement is without prejudice to their right to file one or more continuing applications, as provided in 35 U.S.C. §121, on the subject matter of any claims finally held withdrawn from consideration in this application.

Early and favorable action on the merits of this application is respectfully requested.

Respectfully submitted,

DANN DORFMAN HERRELL and
SKILLMAN, P.C.
Attorneys for Applicant

By _____
Patrick J. Hagan
Registration No. 27,643

PJH:jmn
Enclosure